

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f)(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

[77 FR 48821, Aug. 14, 2012]

#### § 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for re-

issue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

[65 FR 54676, Sept. 8, 2000]

#### § 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable

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application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

[65 FR 54676, Sept. 8, 2000]

### § 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

[65 FR 54676, Sept. 8, 2000, as amended at 69 FR 56544, Sept. 21, 2004; 77 FR 46625, Aug. 6, 2012]

### § 1.179 [Reserved]

#### PETITIONS AND ACTION BY THE DIRECTOR

AUTHORITY: 35 U.S.C. 6; 15 U.S.C. 1113, 1123.

### § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving ac-

tion of the Patent Trial and Appeal Board, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959, as amended at 34 FR 18857, Nov. 26, 1969; 47 FR 41278, Sept. 17, 1982; 49 FR 48452, Dec. 12, 1984; 65 FR 54676, Sept. 8, 2000; 65 FR 76774, Dec. 7, 2000; 69 FR 50000, Aug. 12, 2004; 77 FR 46625, Aug. 6, 2012]